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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/812,353	03/19/2001	Takashi Shinoda	16869P018200	1758
20350	7590	02/25/2005	EXAMINER	
TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			SIMITOSKI, MICHAEL J	
			ART UNIT	PAPER NUMBER
			2134	

DATE MAILED: 02/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/812,353	SHINODA ET AL.	
	Examiner	Art Unit	
	Michael J Simitoski	2134	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 28-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 28-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2/17/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The election of 11/26/04 was received and considered.
2. Claims 28-35 are pending.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 28-35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Regarding claims 28-32, it is unclear how a location can include a route when a route is defined as a course from one location to another.

6. Regarding claims 28-32, it is unclear how the falsification detection module can determine if said contents has been falsified using said Internet Mark, when the Internet Mark is included in the contents; for instance, the IM is created based on the contents (such as a hash of the contents), but if the contents contain the IM, that would mean that the IM depends on the IM.

7. Regarding claims 33-35, it is unclear how the contents can be validated using the cryptographic information when the cryptographic information is included in the contents.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 28 & 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S.

Patent 6,263,313 to Milsted et al. (Milsted) in view of "A Public Key Watermark for Image

Verification and Authentication" by Wong and U.S. Patent 6,351,811 to Groshon et al.

(Groshon). Milsted discloses a falsification detection module/end user for detecting by using a signature (col. 10, lines 1-8), if contents have been falsified (col. 18, lines 38-67) and a

notification module/end user for notifying said server/sender (col. 18, lines 50-55) and said

client/end user of said location when said falsification detection module indicates said contents

has been falsified (at the end user) wherein the location includes a route between said server and

said intermediary/end user (col. 18, lines 50-55). Milsted discloses a digital signature, rather

than an Internet Mark, and lacks sending the document from a server to a client through an

intermediary device. However, Wong teaches that embedding document/image data in the image

(watermarking based on content) allows localized changes in a document to be detected (§2.1 &

§4). Therefore, it would have been obvious to one having ordinary skill in the art at the time the

invention was made to use an Internet Mark. One of ordinary skill in the art would have been

motivated to perform such a modification to detect localized changes in a document, as taught by

Wong (§2.1 & §4). As modified, Milsted lacks sending the document from a server to a client

through an intermediary device. However, Groshon teaches a document validation system where

document validation can occur at an intermediary device/firewall (col. 4, lines 58-63) where a

standard firewall cannot protect against compromised documents (col. 4, lines 38-41).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the

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invention was made to send the document through an intermediary. One of ordinary skill in the art would have been motivated to perform such a modification to allow document validation at a firewall, as taught by Groshon (col. 4, lines 38-63). As modified, Milsted notifies the server and client of the location where said location includes a route between a server and an intermediary device because a display of a verification failure explicitly conveys that the data has been modified between the sender and the receiver and that route must include any intermediary routers.

10. Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Milsted, Wong & Groshon, as applied to claim 28 above, in further view of U.S. Patent 5,930,369 to Cox et al. (Cox). Milsted, as modified above, lacks determining if said Internet Mark was removed from said document. However, Cox teaches that an effective watermark must be difficult to remove where severe degradation in data fidelity occurs before the watermark is removed (col. 1, lines 47-60). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to determine if the Internet Mark was removed from said document. One of ordinary skill in the art would have been motivated to perform such a modification to make use of an effective watermark to detect an attempt to subvert it, as taught by Cox (col. 1, lines 47-60).

11. Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Milsted in view of U.S. Patent 5,606,609 to Houser et al. (Houser). Milsted discloses a falsification detection module for detecting if contents have been falsified (col. 10, lines 1-8 & col. 18, lines 38-67) but

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lacks displaying said location when said falsification detection module indicates said contents has been falsified, wherein said location includes a route between said exit gate/sender and said client/receiver. However, Houser teaches that in a signature verification system, a warning message is displayed to indicate a failure of the verification process (col. 16, lines 34-48).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to display the verification results of Milsted to the client/end user. One of ordinary skill in the art would have been motivated to perform such a modification to display the verification results to the user, as taught by Houser (col. 16, lines 34-48). As modified, Milsted displays a location where said location includes a route between an exit gate and a client because a display of a verification failure explicitly conveys that the data has been modified between the sender and the receiver and that route must include any intermediary routers.

12. Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Milsted & Houser, as applied to claim 31 above, in further view of Cox. Milsted, as modified above, lacks determining if said Internet Mark was removed from said document. However, Cox teaches that an effective watermark must be difficult to remove where severe degradation in data fidelity occurs before the watermark is removed (col. 1, lines 47-60). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to determine if the Internet Mark was removed from said document. One of ordinary skill in the art would have been motivated to perform such a modification to make use of an effective watermark to detect an attempt to subvert it, as taught by Cox (col. 1, lines 47-60).

13. Claims 33-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,092,191 to Shimbo et al. (Shimbo) in view of Groshon and Wong. Regarding claims 33-35, Shimbo discloses sending a document by a server/source gateway to an intermediate/next security gateway (col. 11, line 53 – col. 12, line 28) over a first path, when said server/source gateway validates the contents using embedded cryptographic information/authentication code (col. 11, line 53 – col. 12, line 28) and sending said document by said intermediate computer/next gateway to said client/destination side gateway over said second path, when said intermediate computer/next gateway validates said contents using said embedded cryptographic information/authentication code (col. 11, line 53 – col. 12, line 28). It is inherent that the location of falsification of contents is determined to be the first path if said intermediate computer/next gateway determines said contents have been falsified or said second path if said client/destination side gateway determines said contents have been falsified because for the intermediate to receive the file, it is required that the previous node validate the data and for the client/destination side gateway to have received the file, it is required that the intermediate/next gateway validate the data (col. 12, lines 22-28 & col. 13, lines 6-18). Shimbo lacks a document and lacks an Internet Mark with the cryptographic information embedded. However, Groshon teaches that by validating a web page, which can be performed on a firewall, a user can be sure the content hasn't been compromised (col. 3, lines 5-24 & col. 4, lines 38-63). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the nodes in the Shimbo reference to authenticate a document/HTML file as described by Groshon. One of ordinary skill in the art would have been motivated to perform such a modification to assure a user that the web page hasn't been compromised, as taught by

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Groshon (col. 3, lines 5-24 & col. 4, lines 38-63). Further, Wong teaches that using public key cryptography, a watermark can be embedded in an image/document that contains identifying information of the image/document (§2). This enables a user to verify the contents (§4).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use an Internet Mark. One of ordinary skill in the art would have been motivated to perform such a modification to authenticate an image/document, as taught by Wong (§2 & §4).

Conclusion

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J. Simitoski whose telephone number is (571) 272-3841. The examiner can normally be reached on Monday - Thursday, 6:45 a.m. - 4:15 p.m.. The examiner can also be reached on alternate Fridays from 6:45 a.m. – 3:15 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Morse can be reached at (571) 272-3838.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, DC 20231

Or faxed to:

(703)746-7239 (for formal communications intended for entry)

Or:

(571)273-3841 (Examiner's fax, for informal or draft communications, please label "PROPOSED" or "DRAFT")

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2100.

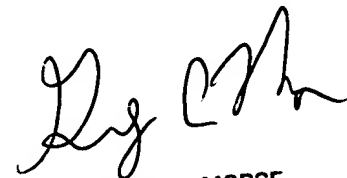
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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



MJS

February 14, 2005



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